

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

I. Disposition of Claims

Claims 1-11 were pending in this application. By way of this reply, claims 1-11 have been canceled without prejudice or disclaimer and claims 12-32 have been added. Claim 12 is independent. The remaining claims depend, directly or indirectly, from claim 12.

II. Claim Amendments

New claims 12-32 have been added in this reply. Support for these amendments may be found, for example, in Figs. 1B and 4, and paragraphs 0030, 0031, 0034, 0037, 0039, and 0041 of the original specification. No new matter has been added.

III. Rejection(s) under 35 U.S.C § 103

Claims 1 and 3-11 stand rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 5,673,090 (“Higuchi et al.”) in view of U.S. Patent No. 6,532,004 (“Harrison et al.”). Claims 1 and 3-11 have been canceled. Thus, the rejection is now moot.

Claim 2 stands rejected under 35 U.S.C. § 103 as unpatentable over Higuchi et al. in view of Harrison et al. and further in view of U.S. Patent No. 5,718,605 (“Morikawa et al.”). Claim 2 has been canceled. Thus, the rejection is now moot.

New claims 12-32 have been added in this reply. To the extent that the rejections may apply to the new claims, the rejections are respectfully traversed.

Independent claim 12 recites a structure of a television with a built-in DVD device. Specifically, as shown in Fig. 1B, the television with a built-in DVD device of the present invention has a shielding case covering both the DVD device and a filter substrate, which allows high-frequency noise to be reduced. More specifically, claim 12 includes inter alia, the limitations of “a shielding case disposed within the cabinet,” “a DVD device disposed within the shielding case,” and “a filter substrate disposed within the shielding case and operatively connected to both the DVD device and the television circuit substrate, the filter substrate acting to reduce a noise component flowing from the DVD device.”

Higuchi et al., in contrast, does not disclose all the limitations as recited in new independent claim 12. In the final Office Action, it was asserted that a printed circuit board for video 133 anticipates the filter substrate as recited in the claims because the printed circuit board 133 minimizes the influence of magnetic force to a video recorder or player. Similarly, it was asserted that the connector 15 also anticipates the filter substrate as recited in the claims for similar reasons. Applicant respectfully disagrees. Applicant submits that Higuchi et al. does not disclose the filter substrate as recited in claim 12. For example, Higuchi et al. states:

- “The printed circuit board for television is provided with the common power for the television and video recorder or player.” (col. 2, lines 21-23);
- “Since the power source is common and attached to the printed circuit board for television, the negative influence of magnetic force to the video recorder or player is avoidable.” (col. 2, lines 39-41); and

-- "(4) Since the power source for video does not exist on the printed circuit board of the video recorder or player, but is provided on the printed circuit board for television as a common power source, there is no negative influence due to the magnetic line of force of the power source." (col. 4, lines 45-49).

As is ascertainable from the above quotations, the reason the influence of magnetic force is minimized is that the printed circuit board for video 133 and the printed circuit board for television 143 share a common power source, i.e., a switching power 16. In other words, by way of providing the common power source on the printed circuit board for television 143, Higuchi et al. prevents the magnetic force generated by the power source from flowing into the printed circuit board for video 133. The printed circuit board for video 133 *per se* does not serve as a filter that reduces a noise component flowing from another device. Thus, the printed circuit board for video 133 is not the same as, or equivalent to, the filter substrate as recited in claim 12.

Also, with respect to the connector 15, Higuchi et al. states:

-- "The numeral 15 is a connector which connects the printed circuit board for video 133 ...and the printed circuit board for television ... and are removable from each other." (col. 3, lines 44-47).

From the above quotation, it is clear that the connector 15 disclosed in Higuchi et al. is a mere connecting member, not a filter. The connector 15 does not serve as a filter that reduces a noise component flowing from another device. Thus, the connector 15 disclosed in Higuchi et al. is not the same as, or equivalent to, the filter substrate as recited in claim 12.

Therefore, Higuchi et al. fails to show or suggest the filter substrate as recited in

claim 12.

Higuchi et al. also does not disclose the shielding case, which covers both the DVD device and the filter substrate, as recited in claim 12. Higuchi et al. merely discloses a shield plate 14 mounted over a mechanical deck 123. As is apparent from Figs. 1 and 3 of Higuchi et al., the shield plate 14 does not sufficiently cover the printed circuit board for video 133. As a consequence of this, the shield plate 13 cannot sufficiently prevent high-frequency noise from leaking from the printed circuit board for video 133 to the printed circuit board for television 143.

On the other hand, for example, as shown in Fig. 1B of the present application, the claimed invention isolates the DVD device 1 and the filter substrate 3, in which high-frequency signals may be resident, from the television circuit substrate 5, in which relatively low-frequency signals may be resident, covering both the DVD device 1 and the filter substrate 3 with the shielding case 2. This is mainly to prevent the high-frequency noise generated from the DVD device 1 from inflowing into the television circuit substrate 5. It is noted that the claimed invention allows the high-frequency noise to the television circuit substrate to be effectively prevented by introducing the filter substrate and further covering both the DVD device and the filter substrate with the shielding case.

Additionally, if, *arguendo*, the connector 15 discussed above corresponds to the filter substrate as recited in claim 12, this results in the connector 15 *not* being covered with the shield plate any longer. In view of this, the shield plate 13 disclosed in Higuchi et al. is not the same as, or equivalent to, the shielding case as recited in claim 12. Accordingly, Higuchi et al. also fails to show or suggest the shielding case as recited in claim 12.

Further, Harrison et al. does not teach what Higuchi et al. lacks. Specifically, as

noted by the Examiner, Harrison et al. merely discloses a component system 20 including a DVD player. However, Harrison et al. discloses neither the filter substrate nor the shielding case as recited in claim 12.

Also, Morikawa et al. does not teach what Higuchi et al. and Harrison et al. lack. Morikawa et al. merely discloses a structure of a connector socket preventing interference therein. However, Morikawa et al. discloses neither the filter substrate nor the shielding case as recited in claim 12.

Furthermore, Applicant respectfully submits that without the benefit of the present specification, there exists nothing that would lead one skilled in the art to combine the teachings of Higuchi et al., Harrison et al. and Morikawa et al. There must be a suggestion or motivation to combine the reference teachings to support a proper obviousness rejection.

Specifically, Morikawa et al. fails to recognize the problems being solved by, or appreciate the advantages provided by, the present invention as recited in claims 12. In fact, there is no mention of preventing a high-frequency noise component radiated from the DVD device from inflowing into the television circuit substrate.

Morikawa et al. is directed to a connector socket. Morikawa et al. is not only wholly unrelated to the present invention recited in claim 12, but, it is non-analogous art to the present invention. Applicant respectfully notes that a prior art reference is analogous if the reference is in the field of Applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned. Neither requirement is true with respect to Morikawa et al.

Thus, the Examiner cannot combine prior art references to render a claimed invention obvious by merely showing that the prior art references are combinable. Instead,

there must be a suggestion or motivation to combine the references with in the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must be an indication within the prior art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added).

Furthermore, Applicant believes that the obviousness rejection is based on improper hindsight reconstruction. See MPEP §2145. The Specification of this application discloses that the present invention arises from employing the filter substrate and the shielding case in a manner that had not been previously attempted. Applicant believes that this knowledge provides the only basis for the alleged obviousness of the limitations as recited in claim 12 in view of the disclosure of Higuchi et al. Without reference to the Specification, one of ordinary skill in the art would not look to modify the cited prior art teachings to achieve the present invention.

In addition, as noted by the Examiner in the Office Action dated February 10, 2004, Official Notice was taken that using a connector which is connected through a plurality of metal pins is old and well known in the art. Applicant respectfully disagrees with the position asserted in this Official Notice and requests that the Examiner provide evidence to support this position either in the form of prior art or by providing a declaration of personal knowledge pursuant to 37 C.F.R. 1.104 (d) (2). The present invention allows the plurality of metal pins to even out fluctuations in a level of a high-frequency noise. See, for example, paragraph 0047 of the original specification.

Also, Official Notice was taken, with respect to using a pattern acting as a ground level of a power substrate that is directly connected to a shielding case being old and ell

known in the art. Applicant respectfully disagrees with the Official Notice and requests that the Examiner provide evidence to support this position either in the form of prior art or by providing a declaration of personal knowledge pursuant to 37 C.F.R. 1.104 (d) (2). The pattern, as now recited in new claim 20, is directly electrically connected to the shielding case. By way of this, the present invention allows the leaking noise to the outside of the shielding case to be more suppressed, thereby enhancing the resistance to fracture characteristics to static electricity. See, for example, paragraph 0052 of the original specification.

In view of the above, Higuchi et al., Harrison et al., and Morikawa et al., whether considered separately or in combination, fail to show or suggest the claimed invention as recited in claim 12. In addition, obviousness cannot be established based on the combination of Higuchi et al., Harrison et al., and Morikawa et al. as no motivation to combine the references exists. Thus, new independent claim 12 is patentable over Higuchi et al., Harrison et al., and Morikawa et al. Dependent claims 13-32 are allowable for at least the same reasons. Accordingly, entry and allowance of new claims 12-32 is respectfully requested.

IV. Conclusion

The above amendments and remarks are believed to require no further prior art search or, at least, simply issues for appeal. Accordingly, entry and favorable consideration is respectfully requested. Also, Applicant believes that this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the

undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 04995.027001).

Respectfully submitted,

Date: 10/26/01



Jonathan P. Osha, Reg. No. 33,986
Osha & May L.L.P.
One Houston Center, Suite 2800
1221 McKinney Street
Houston, TX 77010
Telephone: (713) 228-8600
Facsimile: (713) 228-8778

77618_1.DOC